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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,221	06/16/2006	Matthew John O'Sickey	347 US (P31339-A USA)	8232
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FOX ROTHSCHILD LLP 2000 MARKET STREET 10th Floor PHILADELPHIA, PA 19103			EXAMINER CAILLOUET, CHRISTOPHER C	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 01/23/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/583,221

**Applicant(s)**

O'SICKEY ET AL.

**Examiner**

CHRISTOPHER C. CAILLOUET

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 16-20, 28, 29, 40 and 75 is/are pending in the application.
- 4a) Of the above claim(s) 19, 20, 28, 29, 40 and 75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/06/06; 04/11/08.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**Examiner: Caillouet**

**January 16, 2009**

**BREATHABLE ELASTIC LAMINATES AND  
METHODS OF MANUFACTURING SAME**

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Invention I, claims 1-7 and 16-18 in the reply filed on October 30, 2008 is acknowledged. Invention II, Claims 19-20, 28-29, 40 and 75 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***§102 Rejections***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-5, and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Dobrin et al. (US 5628856).

As to claim 1, Dobrin discloses a method for forming a composite elastic material (Abstract). Dobrin's method comprises of: contacting a thermoplastic film (130) with an elastic material (100); introducing multilayered laminate to a vacuum drum (118, 120) wherein the elastic material is interposed between said vacuum drum and non-elastic material; and forming apertures in the laminate with said vacuum drum, forming a breathable composite elastic material (Figure 2; column 5, lines 46-65).

As to claim 3, it is the position of the examiner that the elastic that Dobrin uses in his method would qualify as a "skinless elastic" since Dobrin states that the either one or both elastic strands (105, 106) comprising the elastic material (100) may be elastic (column 6, lines 33-51). A "skinned" elastic material would be one where only one of the strands would be elastic and a "skinless" elastic material would be one where both all of the strands are elastic.

As to claim 4, the method of claim 1 is taught as seen above. Dobrin discloses that apertures are formed in the nonelastic material (Fig. 2; column 5, lines 46-65).

As to claim 5, the method of claim 1 is taught as seen above. Dobrin discloses the use of an aperture definition device (118) between the vacuum (120) and the thermoplastic film (130) (Fig. 2).

As to claims 16-17, Dobrin discloses that the size of the apertures may be modified to be the same size or smaller than the apertures in the elastic material (column 6, line 66 - column 7, line 3), which would inherently effect the breathability of the laminate material.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hutson et al. (US 20030105446).

Hutson discloses a method of forming a breathable elastic (10) wherein: A skinless elastic material (14) is extruded onto a first nonelastic layer (12); the composite web is then contacted with a pressure differential source (34) where the elastic layer (14) is between said vacuum source and first nonelastic layer; said pressure differential source simultaneously bonds and forms apertures in composite web; a second nonelastic layer is laminated to the composite web on the elastic side of said web; the composite web is further processed rollers (42) to stretch said web (Fig 3A; paragraphs 52, 55-57). This reference anticipates the second way of making a multilayered laminate, but not the first way. The Hutson reference has publication date of June 5, 2003. The current application claims benefits of provisional applications 60/530883, filed December 18, 2003 and 60/585186, filed July 2, 2004. The provisional application filed on December 18, 2003 discloses introducing a first non-woven layer to the vacuum forming screen and then extruding the thermoplastic layer onto said first non-woven layer, but not extruding the elastic layer on the vacuum forming screen between the first non-woven layer and said vacuum forming screen, which coincides with the first way of making the laminate disclosed in claim 1 of the current application. A 102(b) rejection is made of claim 1 based upon the second way of forming the laminate and not the first way because the second way was not disclosed in the provisional application filed on December 18, 2003 and therefore the claim is not fully supported by the provisional of

60/530883. Accordingly, claim 1 does not receive benefit of the filing date of the earliest provisional.

In the alternative, there still would be a 103(a) rejection of claim 1 in view of Hutson if the first way of the elastic/nonelastic combination was used as recited.

5. Claims 1-5 and 16-18 are rejected under 35 U.S.C. 102(a) and 102(e) as being anticipated by Hutson et al. (US 20030105446).

The applied reference has a common inventor, Andrew J. Peacock, with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claims 1-5 and 18, Hutson discloses a method of forming a breathable elastic (10) wherein: A skinless elastic material (14) is extruded onto a first nonelastic layer (12); the composite web is then contacted with a pressure differential source (34) where the elastic layer (14) is between said vacuum source and first elastic layer nonelastic layer; said pressure differential source simultaneously bonds and forms apertures in composite web; a second nonelastic layer is laminated to the composite web on the elastic side of said web; the composite web is further processed rollers (42) to stretch said web (Fig 3A; paragraphs 52, 55-57).

As to claim 16, the method of claim 1 is taught as seen above. Hutson discloses that the laminate characteristic is modified by modifying the phase of the elastic, molten or semi-molten, prior to bonding (paragraph 53).

As to claim 17, the method of claim 16 is taught as seen above. Hutson discloses that the laminate characteristic is chosen to provided a fibrous feel that is soft and/or silky (paragraph 50).

### ***§103 Rejections***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 20030124310) in view of Dobrin et al. (US 5628856).

As to claims 1, 6, and 18, Ellis discloses a method of producing elastic laminate materials (Abstract). Ellis discloses that the elastic laminate is composed of a non-woven fibrous web and an elastic material (paragraph 8). Ellis further discloses that the laminate may be a two layer composite, elastic and non-woven web, or a three layer composite wherein the elastic material is laminated between two nonwoven webs (paragraph 10). Ellis discloses that an elastic material (42) is extruded between two non-bonded webs (12, 22) and the elastic laminate is then formed by lamination bonding press rollers (64, 74) (Fig. 2, paragraph 54). Ellis discloses that further

finishing steps may be performed on the composite web such as aperturing, slitting, stretching (Claim 18), or further lamination (paragraph 60).

Ellis fails to disclose the use of a vacuum drum to simultaneously bond the webs of materials together and form apertures therein. It is the position of the examiner that using a vacuum drum to simultaneously bond webs of material and form apertures in said webs is well known in the art and would have been obvious at the time of the invention. Dobrin discloses a method for forming a breathable composite elastic material (Abstract). Dobrin's method comprises of: contacting a thermoplastic film (130) with an elastic material (100); introducing the multilayered laminate to a vacuum drum (118, 120) wherein the elastic material is interposed between said vacuum source and non-elastic material; simultaneously laminating and forming apertures in the laminate with said vacuum drum, thus forming a breathable composite elastic material (Figure 2; column 5, lines 46-65). It would have been obvious to one of ordinary skill to incorporate a known successful method of forming an apertured composite web, such as the method disclosed by Dobrin, into the method of Ellis because one of ordinary skill would recognize the benefit minimizing necessary process steps in order to produce the apertured laminated structure of Ellis's method.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the lamination method of Dobrin for the lamination method of Ellis because one of ordinary skill in the art would have been able to carry out such a substitution to achieve the predictable result of forming an elastic composite with apertures. "The combination of familiar elements according to known methods is likely



to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

As to claim 2, the method of claim 1 is taught as seen above. Ellis discloses that a third non-woven (22) material may be introduced to the first (12) or second non-woven (42) materials to form a multilayered laminate.

As to claim 3, it is the position of the examiner that the elastic that Dobrin uses in his method would qualify as a "skinless elastic" since Dobrin states that the either one or both elastic strands (105, 106) comprising the elastic material (100) may be elastic (column 6, lines 33-51). A "skinned" elastic material would be one where only one of the strands would be elastic and a "skinless" elastic material would be one where both all of the strands are elastic.

As to claim 4, the method of claim 1 is taught as seen above. Ellis discloses that the non elastic material may be apertured (paragraph 60).

As to claim 5, the method of claim 1 is taught as seen above. As stated in the rejection above, Dobrin discloses the use of an aperture definition device (118) on the vacuum drum (120) (Fig. 2).

As to claim 7, the method of claim 6 is taught as seen above. Ellis discloses that the combined laminate is introduced to a pressure source through further lamination and/or stretching (paragraph 60).

8. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutson et al. (US 20030105446) as applied to claim 1 above.

As to claims 6 and 7, the method of claim 1 is taught as seen above. Hutson et al. fails to disclose laminating the elastic layer between the first and second non-elastic layers and contacting the composite structure to the vacuum drum through the second non-elastic layer. Hutson discloses a second method to form the above mentioned composite laminate with the elastic layer interposed in between the non-elastic layers wherein: the elastic (14) is extruded between the first and second non-elastic layers (12, 16); the layers are bonded to one another as they pass through nip rollers (40); apertures are formed in the composite laminate followed by a stretching process (Fig. 4; paragraph 56). It would have been obvious to one of ordinary skill in the art that the vacuum drum of the first method could be incorporated into the second method in order to simultaneously bond the composite laminate instead of using pins to pierce the composite, because such a substitution would be within his technical grasp.

### ***§112 Rejections***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation, "A method for forming a laminate as in claim 1 further comprising: introducing a third nonwoven material to said first or said second nonwoven material." There is insufficient antecedent basis for this limitation in the claim.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER C. CAILLOUET whose telephone number is (571)270-3968. The examiner can normally be reached on Monday - Thursday; 9:30am-4:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Caillouet/  
Examiner, Art Unit 1791

/Mark A Osele/  
Primary Examiner, Art Unit 1791  
January 21, 2009